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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/940,544	09/30/97	SADELAIN	MSK-P-035-US

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HM12/0330

EXAMINER  
HELMS, L

ART UNIT	PAPER NUMBER
1642	21

DATE MAILED: 03/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/940,544**

Applicant(s)

**Sadelain et al**

Examiner  
**Larry R. Helms Ph.D.**

Group Art Unit  
**1642**



☒ Responsive to communication(s) filed on 19 Mar 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) 8-20 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 3/19/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/940,544 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 8-20 are withdrawn from consideration.  
Claims 1-7 are under examination.
3. The text of those sections of title 35, USC Code not included on the Office Action can be found in a prior Office Action.
4. The response filed 3/19/01 as paper #20 has been considered carefully but is deemed not persuasive because the rejections and objections have not been adequately addressed either by claim amendment or by argument.

### ***Response to Arguments***

#### ***Double Patenting***

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5. The rejection of claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/142974 in view of Alvarez-Vallina et al and Sambrook et al is maintained for the reasons of record. The response filed 3/19/01 did not address this rejection.

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6. The rejection of claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/142974 in view of Eshhar et al (WO 93/19163, published 9/30/93), Fouser et al (WO 92/18629, published 10/29/92) and Sambrook et al (Molecular Cloning: A Laboratory Manual, Cold Spring Harbor Laboratory, 1989) is maintained. The response filed 3/19/01 did not address this rejection.

***Claim Rejections - 35 USC § 103***

7. The rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Cheung et al et al (WO 97/34634, published 9/25/97, Information Disclosure Statement filed 6/3/98), and further in view of Alvarez-Villina et al (Eur. J. Immunol. (1996) 26:2304-209, Information Disclosure Statement filed 6/3/98) and Sambrook et al (Molecular Cloning A Laboratory Manual, Cold Spring Harbor Laboratory, 1989) is maintained for the reasons of record. The response filed 3/19/01 did not address this rejection.

8. The rejection of claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Cheung et al and further in view of Alvarez-Vallina et al is maintained for reasons of record. The response filed 3/19/01 did not address this rejection.

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9. The rejection of claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Eshhar et al (WO 93/19163, published 9/30/93) and further in view of Fouser et al (WO 92/18629) is maintained. The response filed 3/19/01 did not address this rejection.

10. The rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Eshhar et al (WO 93/19163, published 9/30/93) and further in view of Fouser et al (WO 92/18629, published 10/29/92) and Sambrook et al (Molecular Cloning: A Laboratory Manual, Cold Spring Harbor Laboratory, 1989) is maintained. The response filed 3/19/01 did not address this rejection.

***Claim Rejections - 35 USC § 102***

D 11. The rejection of claims 1-2 under 35 U.S.C. 102(a) as being anticipated by Alvarez-Vallina et al (Eur. J. Immunol. (10/1996) 26, pp 2304-2309, Information Disclosure Statement, filed 6/3/98) is maintained. The response filed 3/30/01 did not address this rejection.

12. The rejection of claims 1-2 under 35 U.S.C. 102(b) as being anticipated by Eshhar et al (WO 93/19163, published 9/30/93) is maintained. The response filed 3/19/01 did not address this rejection.

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*Conclusions*

13. No Claims are allowed.

14. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with

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alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

16. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Respectfully,

Larry R. Helms Ph.D.

703-306-5879

  
SHEELA HUFF  
PRIMARY EXAMINER